

### **REMARKS/ARGUMENTS**

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

Claim 12 was objected to for informalities. Claim 12 has been amended to place it in independent form, rendering the objection moot.

Claim 14 was objected to for informalities. Claim 14 has been amended appropriately to obviate the objection.

Claims 1 and 12 were rejected under 35 U.S.C. 102(e) over U.S. Patent No. 6,628,788 to Azizi. Claims 1 and 12 have been amended to better distinguish from the prior art. For the following reasons the rejection has been rendered moot by the amendment.

Regarding amended claims 1 and 12, Azizi does not teach a threshold value being controlled independently of an output signal, as required. In Azizi, the volume of an output signal (of volume control unit 3) is adjusted on the basis of a difference (see subtractor 14) between the output signal and a signal received from a microphone (13). The Examiner cited the input of the microphone (13) in Azizi as being the input signal required by claim 1. Azizi depends upon the output of its volume control unit (3) for calculating the amplification gradation used to control the volume control unit (3). Since it depends on the output, the amplification gradation of Azizi is not *independent of the output*, as in the claimed invention. Therefore, since every limitation of the claim is not taught by the reference, amended claims 1 and 12 are not anticipated by Azizi.

Claims 2-11 and 13-20 were rejected under 35 U.S.C. 103(a) over Azizi. For the

following reasons, the rejection is respectfully traversed.

The Examiner states that each of required limitations are well known in the art, and therefore one of ordinary skill in the art would have been “motivated to select a desirable well-known processing algorithm for the processing . . . in order to obtain desirable acoustic effects.” Applicant respectfully submits that the mere fact that the proposed modifications are known and would provide a benefit does not replace an actual suggestion to make the modification. Nearly all inventions are non-obvious combinations of known elements that provide some advantage. “The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” (MPEP § 2142). Applicants respectfully submit that the Examiner has not provided sufficient factual support to reach a conclusion of obviousness, and thus a *prima facie* case of obviousness has not been made. Furthermore:

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

(MPEP § 2143.01, *emphasis added*). If the Examiner intends to maintain the rejection, the Applicants respectfully request that the Examiner explain, in addition to the mere fact that one of ordinary skill in the art would have known how to made the proposed modifications, where motivation to modify the teachings of Azizi to arrive at each of the claims can be found *in the prior art*.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the

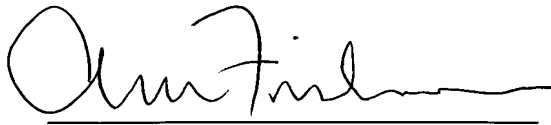
Appl. No. 09/924,753  
Amdt. Dated August 30, 2004  
Reply to Office action of March 29, 2004

application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33868.

Respectfully submitted,

PEARNE & GORDON LLP

By:   
Aaron A. Fishman, Reg. No. 44682

1801 East 9th Street  
Suite 1200  
Cleveland, Ohio 44114-3108  
(216) 579-1700

Date: August 30, 2004